

R E M A R K S

Drawing

It is respectfully requested that the originally filed drawing (Fig. 1, one sheet) be approved.

Claim Amendments

Claim 1 was amended to recite specific polysaccharides that are supported in the specification on page 11. All of these polysaccharides affect the phase-transition (solution state at high temperature and gel state at low temperature), which is important in the presently claimed invention.

Claim 1 was also amended to include the features of claim 4.

Claims 6 and 8 were amended to delete multiple dependencies.

Claim 9 was amended to depend on claim 1. If claim 1 is allowed, rejoinder and allowance of claim 9 is respectfully requested.

The dependency of claim 19 was amended.

Editorial revisions were made to claims 1, 6, 9, 12 and 19.

Claim Objections

1. Claims 6 to 8 were objected to under 37 CFR 1.75(c) for the reasons set forth in the first paragraph on page 3 of the Office Action.

Claims 6 and 8 were amended to avoid the claim objections regarding these claims.

2. Claims 1 to 5 were objected to for the reason set forth in the second paragraph on page 5 of the Office Action.

Claim 1 was amended to avoid this claim objection.

Withdrawal of the claim objections is respectfully requested.

Rejections Under 35 USC 112, First Paragraph

1. Claims 1 to 5 were rejected under 35 USC 112, first paragraph, as allegedly failing to comply with the "written description requirement" for the reasons beginning at the middle of page 3 and continuing to page 7, line 9 of the Office Action.

The position taken in the Office Action is that whereas the claims refer to a polysaccharide, the only polysaccharide described in the specification that the Examiner considers to meet the "written description requirement" is agar. Perhaps the Examiner took this position because agar is the only polysaccharide used in the inventive Examples. However, page 11, lines 1 to 21 of the specification provide a generic description

of the polysaccharide ("carbohydrate which generates two or more molecules through hydrolysis"). Also, specific examples of polysaccharides are set forth on page 11, lines 7 to 21 of the specification.

In view of the above amendment to claim 1, wherein eight specific polysaccharides that are disclosed on page 11 of the specification are recited, withdrawal of this ground of rejection is respectfully requested.

2. Claims 1 to 5 were rejected under 35 USC 112, first paragraph, for allegedly not being enabling for the reasons set forth beginning on page 7, line 10 and continuing to the bottom of page 10 of the Office Action.

The position taken in the Office Action is that the claims are enabling for the polysaccharide being agar, but do not reasonably provide enablement for all polysaccharides.

For the following reasons, it is respectfully submitted that the eight specific polysaccharides are enabled by the specification.

The Examiner is apparently trying to limit applicants only to their working example (agar as the polysaccharide), and this is improper.

See In re Anderson, 176 USPQ 331, 333 (CCPA, 1973), where the Court held as follows:

"...we do not regard §112, first paragraph, as requiring a specific example of everything within the scope of a broad claim...What the Patent Office is here apparently attempting is to limit all claims to the specific examples, notwithstanding the disclosure of a broader invention. This it may not do."

Further support for such proposition is found in In re Kamal and Rogier, 158 USPQ 320, 323 (CCPA, 1968). Quoting from In re Grimme, Keil, and Schmitz, 124 USPQ 499, 502 (CCPA, 1960), the Court stated:

"It is manifestly impracticable for an applicant who discloses a generic invention to give an example of every species falling within it, or even to name every such species. It is sufficient if the disclosure teaches those skilled in the art what the invention is and how to practice it."

Indeed, examples per se are not required to satisfy the requirements of 35 U.S.C. 112, first paragraph. See In re Strahilevitz, 212 USPQ 561, 562-563 (CCPA 1982); In re Stephens, 188 USPQ 659, 660-662 (CCPA 1976); In re Borkowski, 164 USPQ 642, 645-646 (CCPA 1970); In re Gay, 135 USPQ 311, 316 (CCPA 1962).

The Court held in In re Robins, 166 USPQ 552, 555-556 (CCPA 1970) that working examples are only one means of satisfying the enablement requirement of 35 U.S.C. 112 and that the mere listing of specific compounds, chemical substituents, solvents, cross-linking agents, etc. in the specification would in most cases provide suitable evidence of enablement equivalent to specific working examples utilizing each of the various components.

The disclosure as set forth by the applicants in the application must be given the presumption of correctness and operativeness by the USPTO. The only relevant concern of the USPTO is the truth of the assertions in the application. In any event, the burden is on the USPTO whenever a rejection is made for lack of enablement under Section 112. The Examiner must explain why he doubts the truth or accuracy of the statements in

a supporting disclosure to which he objects. The Examiner must back up such assertions with acceptable evidence or reasoning which contradicts applicants' contentions. See, for example, In re Marzocchi, 169 USPQ 367, 369-370 (CCPA 1967) and In re Bowen, 181 USPQ 48, 50-52 (CCPA 1974).

It is respectfully submitted that the Examiner in the case at hand has not carried his burden of showing the applicants' specification to be untrue or inaccurate.

Applicants do not believe that undue experimentation would be necessary for one skilled in the art to practice their invention. Assuming *arguendo* that a certain, limited degree of experimentation would be required for one skilled in that art to reproduce applicants' invention, such experimentation would not deter from applicants' satisfaction of the enablement under 35 U.S.C. 112. See for example, In re Miller, 169 USPQ 59, 602 (CCPA 1971); In re Angstadt, 190 USPQ 214, 218-219 (CCPA 1976); Ansul Company v. Uniroyal, Inc., 169 USPQ 759, 763 (2d Cir. 1971) cert. denied, 172 USPQ 257 (1972); and Caldwell v. The United States, 175 USPQ 44, 47-48 (U.S. Ct. Cls. 1972).

It should be further noted that only those skilled in the art must be enabled, not the general public. In re Storrs, 114, USPQ 293, 296-297 (CCPA 1957).

Based on the above, applicants respectfully solicit withdrawal of each of the rejections of claims under 35 U.S.C. 112, first paragraph.

Anticipation Rejections Under 35 USC 102

1. Claims 1 to 5 were rejected under 35 USC 102 as being anticipated by Inohara et al. (WO 2003/013612, published February 20, 2003) (equivalent to US 2004/0266725) for the reasons stated on page 11 of the Office Action. It was stated in the Office Action that evidence of inherent properties is provided by the Merck Index (entry for Dextrin-Maltose, Merck Index, cited in the PTO-892 Form attached to the Office Action).

It was admitted in the Office Action that Inohara et al. is silent as to the amount of precipitated polysaccharide after performing centrifugal separation at 25°C with 40,000xg for one hour.

Inohara et al. relate to a liquefied polysaccharide comprising gel particles essential in providing drug retention, whereas the presently claimed invention relates to a polysaccharide sol for improving moisture retention. Inohara et al. and the presently claimed invention are thus completely different.

2. Claims 1 to 4 were rejected under 35 USC 102 as being anticipated by Johnson et al., Cereal Chemistry, (1975), 52, pp. 70-78 for the reasons set forth on page 12 of the Office Action.

The Johnson et al., Cereal Chemistry reference refers to partially hydrolyzed dextrose starch. Starch is in a state of solution at a normal temperature and in a state of a glue at a high temperature. Accordingly, dextrose starch has a substantially different nature from the polysaccharides recited in applicants' present claims.

Withdrawal of each of the 35 USC 102 rejections is therefore respectfully requested.

Obviousness Rejection Under 35 USC 103

Claims 1 to 5 were rejected under 35 USC 103 as being unpatentable over Johnson et al., Cereal Chemistry, (1975), 52, pp. 70-78 for the reasons indicated on pages 13 to 14 of the Office Action.

It was admitted in the Office Action that Johnson et al. do not specifically disclose a composition wherein the polysaccharide has a concentration of from 0.0002 to 0.5 wt.% (see applicants' claim 5).

In view of the admission in the Office Action as set forth in the preceding paragraph and for the reasons discussed above in conjunction with the 35 USC 102 rejection based on Johnson et al., withdrawal of the 35 USC 103 rejection is respectfully requested.

Obviousness-Type Double Patenting Rejections

1. Claims 1 to 5 were provisionally rejected on the ground of obviousness-type double patenting over claims 1 to 16, 50, 51 and 52 of the copending application Serial No. 10/486,122 for the reasons set forth on pages 4 to 15 of the Office Action.

It was admitted in the Office Action that the claims of copending application Serial No. 10/486,122 are silent as to the amount of precipitated polysaccharide after performing centrifugal separation at 25°C with 40,000 xg for one hour.

2. Claims 1 to 5 were provisionally rejected on the ground of obviousness-type double patenting over claims of the copending application Serial No. 11/810,524 for the reasons set forth on pages 16 to 17 of the Office Action.

It was admitted in the Office Action that the claims of copending application Serial No. 11/810,524 are silent as to the amount of precipitated polysaccharide after performing centrifugal separation at 25°C with 40,000 xg for one hour.

The two double patenting rejections are premature until allowable subject matter is indicated in the above-identified application or in the copending applications.

Reconsideration is requested. Allowance is solicited.

If the Examiner has any comments, questions, objections or recommendations, the Examiner is invited to telephone the

undersigned at the telephone number given below for prompt
action.

Frishauf, Holtz, Goodman
& Chick, P.C.
220 Fifth Avenue, 16th Fl.
New York, NY 10001-7708
Tel. Nos. (212) 319-4900
(212) 319-4551/Ext. 219
Fax No.: (212) 319-5101
E-Mail Address: BARTH@FHGC-LAW.COM
RSB/ddf

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Richard S. Barth", written in dark ink.

Richard S. Barth
Reg. No. 28,180